The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JULIE A. MEEK,
BRENDA L. LYON and WENDY D. LYNCH

Appeal No. 2005-0307
Application No. 09/520,419

ON BRIEF

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JAN 12 2006
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BOARD OF PATENT APPEALS
AND INTERFERENCES

Before HAIRSTON, BARRETT, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4, 7-10, and 22. Claims 5, 11-21, and 23-27 have been canceled. Despite any indications to the contrary, claim 6 is not before this Board as there is no outstanding rejection thereof in the record before us.

Invention

Appellants' invention relates to a method of managing healthcare services. One step of the method includes collecting information from an individual for a predetermined set of predictive factors. Another step of the method includes assigning, based upon the information from the individual, a separate value to each predictive factor of the predetermined set of predictive factors. The method further includes the step of generating, based upon a predetermined predictive model and the separate values assigned to the predetermined set of predictive factors, a risk level of the individual utilizing healthcare services at a predetermined level within a prospective time span. Appellants' specification at page 2, lines 10-18.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of managing healthcare services, comprising the steps of:

collecting information from an individual for a predetermined set of predictive factors;

assigning, based upon said information from said individual, a separate value to each predictive factor of said predetermined set of predictive factors;

generating, based upon a predetermined predictive model and said separate values assigned to said predetermined set of predictive factors, a risk level of said individual utilizing healthcare services at a predetermined level within a prospective time span;

wherein said assigning step comprises the steps of:

determining, based upon said information, whether a first predictive factor is indicative of a high risk of said individual utilizing said healthcare services at said predetermined level within said prospective time span;

assigning, based upon said information, a first dichotomous value to said separate value for said first predictive factor if said determining step determines that said first predictive factor is

indicative of said high risk of said individual utilizing said healthcare services at said predetermined level within said prospective time span; and

assigning, based upon said information, a second dichotomous value to said separate value for said first predictive factor if said determining step determines that said first predictive factor is not indicative of said high risk of said individual utilizing said healthcare services at said predetermined level within said prospective time span.

References

The references relied on by the Examiner are as follows:

Mebane	5,486,999	Jan. 23, 1996
Wong et al. (Wong)	5,976,082	Nov. 2, 1999
Silver	6,269,339	July 31, 2001 (filed Dec. 29, 1998)

Rejections At Issue[1]

Claims 1, 8-10, and 22 stand rejected under 35 U.S.C. § 102 as being anticipated by Wong.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wong and Mebane.

Claim 4 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wong and Silver.

Claim 7 stand rejected under 35 U.S.C. § 103 as being obvious over Wong.

[1] Despite any indications to the contrary, claim 22 is not before this Board for a rejection under new matter as no such rejection is present in the Examiner's answer.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.[2]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we affirm the Examiner's rejection of claims 1, 8-10, and 22 under 35 U.S.C. § 102; and we affirm the Examiner's rejection of claims 2-4 and 7 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal the claims stand or fall together. See page 3 of the brief. We will, thereby, consider Appellants' claims 1, 8-10, and 22 as standing or falling together, and we will treat claim 1 as representative of claims 1, 8-10, and 22.

[2] Appellants filed an appeal brief on January 15, 2004. The Examiner mailed an Examiner's Answer on May 19, 2004.

I. Whether the Rejection of Claims 1, 8-10, and 22 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Wong does fully meet the invention as recited in claims 1, 8-10, and 22. Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue at page 5 of the brief, "the disclosed step in Wong of determining that a first predictor is correlated or in some way relates to a patient's healthcare use does not constitute disclosure of determining whether a factor indicates a high risk of healthcare use." The Examiner responds at page 18 of the answer that this determining is the "identification technique" taught at column 5, line 16 of Wong. We find the Examiner's position to be persuasive. However, given that this is the first point in the record before us where the Examiner has explained this portion of the rejection to Appellants, we must also note that the Examiner has presented a new ground of rejection.

With respect to Appellant's "assigning steps" argument at pages 6-8 of the brief, we reach the same conclusion as above. The Examiner presents for the first time in the answer a detailed explanation of how Wong teaches the assigning steps. While we strongly agree with Appellants' position at page 6 of the brief that prior to the answer, "it is entirely unclear ... after careful

review of these passages, where the Examiner finds specific support for her rejection." Again the Examiner has presented a persuasive rebuttal at pages 18-20 of the answer. The examiner explains for the first time that the variables numbered 5-10 at column 12, lines 53-58, of Wong, meet the limitations of the assigning steps. We find the Examiner's position to be persuasive.

This panel notes that it is not until the answer that the Examiner provides the Appellants with an adequate explanation of how Wong teaches the claimed invention. While we find this highly objectionable, we lack the authority to provide any corrective relief. However, the Examiner should note that had her explanation in the answer been lacking in even the most minor aspect, this panel would have reversed the rejection on the basis that the Examiner's earlier office actions never came close to meeting the burden of establishing a **prima facie** case of anticipation. The Appellants are entitled to a complete first office action and should not have to file an appeal to see for the first time the explanations that would have completed the first office action.

For the reasons above, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 2-4 and 7 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 2-4 and 7. Accordingly, we affirm.

With respect to dependent claims 2-4 and 7, Appellants present no arguments in addition to those already noted above with respect to claim 1. Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above as the Appellants have shown no error in the Examiner's rejection.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 1, 8-10, and 22; and we have sustained the rejection under 35 U.S.C. § 103 of claims 2-4 and 7.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON
Administrative Patent Judge

LEE E. BARRETT
Administrative Patent Judge

ALLEN R. MACDONALD
Administrative Patent Judge

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